

### **REMARKS**

Favorable reconsideration of this application is respectfully requested, as amended. Claims 1, 3-18 and 21-25 are currently pending.

Applicants kindly acknowledge the statement at page 2 of the Office Action that the following rejection has been withdrawn: Claim 22 as objected to under 37 C.F.R. § 1.75 as being substantially duplicative of Claim 21.

Claims 19-20 have been cancelled.

Claims 1 and 21-22 have been amended to recite a composition or device comprising a combination of a first group of naturally occurring elements and a second group of naturally occurring elements, and to delete reference to the combination providing a therapeutic benefit. Support for the amendments to Claims 1 and 21-22 may be found, for example, in paragraph [0008] at page 3 of the present application. In view of the amendments to Claims 1 and 22, the language of Claims 3-6, 10 and 16-18 (which ultimately depend from amended Claim 1), and Claims 23-25 (which ultimately depend from amended Claim 21) has been amended accordingly.

Claim 1 has been further amended to recite that the first group of elements is selected from: charoite, rhyolite, charoite and rhyolite, or a combination of at least one of charoite and rhyolite with at least one of rubellite and rubellite with quartz. Claim 1 has also been amended to recite that the second group of elements is selected from: tourmaline, and a combination of tourmaline with at least one of: alexandrite, amazonite, amber, amethyst, aquamarine, aventurine, azurite, bloodstone, calcite, carelian, celestite, chrysoprase, citrine, copper, diamond, diopase, emerald, fluorite, garnet, gold, hematite, Herkimer diamond, jade, jasper, kunzite pink, lapis lazuli, lepidolite, malachite, manganese, moonstone, moss agate, obsidian, onyx, opal, peridot, pyrite, quartz crystal, rhodochrosite, rhodonite, rose quartz, ruby, rutilated quartz, smoky quartz, sugilite, sodalite, sapphire, silver, tiger eye, topaz, tourmaline, turquoise and zircon. Support for the amendments to Claim 1 may be found in paragraphs [0011]-[0012] at page 4 of the present application.

Claim 6 has been further amended to clarify that the recited combination comprises all of the following elements: moss agate, amethyst, aquamarine, charoite, citrine, emerald, fluorite, garnet, peridot, rubellite, rubellite with quartz, ruby, sapphire, turquoise, pyrite, moonstone, rhyolite, tourmaline, sugilite, sodalite, black onyx, Herkimer diamond,

pyrite, rainbow moonstone, rhyolite and quartz. Support for the amendments to Claim 6 may also be found in paragraph [0012] at pages 4-5 of the present application.

Claim 21 has been further amended to clarify that the first group of naturally occurring elements is selected from: (1) a combination of pearl and rhyolite; or (2) a combination of charoite, rubellite, rubellite with quartz, pearl and rhyolite.

Claim 22 has been amended similar to Claim 1 to recite that the first group of elements is selected from: charoite, rhyolite, charoite and rhyolite, or a combination of at least one of charoite and rhyolite with at least one of rubellite and rubellite with quartz. Support for the amendments to Claim 21 may be found in paragraphs [0011] at page 4 of the present application.

**A. Response to Rejection of Claims 1 and 3-25 under 35 U.S.C. § 112, First Paragraph**

At pages 2-8 of the Office Action, Claims 1 and 3-25 have been rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the enable requirement. Specifically, the Office Action alleges that Claims 1 and 21, in reciting “a combination providing therapeutic benefit,” fails to provide information to one skilled in the art “to fully practice” the claimed invention “without undue experimentation.”

For reasons previously stated by Applicants in their prior amendments, Applicants do not agree with the allegations in the Office Action that Claims 1 and 3-25, in reciting that the combination “provides a therapeutic benefit,” lack enablement under 35 U.S.C. § 112, first paragraph. Applicants especially disagree with the allegations in the Office Action that the present application fails to provide information to one skilled in the art “to fully practice” the claimed invention “without undue experimentation.”

Nonetheless, in response to this rejection and in the interest of advancing the prosecution of the present application, Claims 1 and 21-22 have been amended to recite a composition or device comprising the combination of first and second group elements, and to delete all reference to the combination providing a therapeutic benefit. Claims 19-20 have also been cancelled in response to this rejection, and the language of Claims 3-6, 10 and 16-18 (which ultimately depend from amended Claim 1), and Claims 23-25 (which ultimately depend from amended Claim 21) has been amended accordingly.

By deleting all reference to the combination providing a therapeutic benefit, which is the only aspect of the claimed invention that the Office Action alleges lacks enablement, Claims 1, 3-18 and 21-25, as amended or as currently presented, have overcome this rejection under 35 U.S.C. § 112, first paragraph.

**B. Response to Rejection of Claims 1, 3, 7-10, 16 and 18-22 under 35 U.S.C. § 102(b) as Anticipated by Ridgely *et al.* '138**

At pages 9-10 of the Office Action, Claims 1, 3, 7-10, 16 and 18-22 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6,378,138 to Ridgely *et al.* (Ridgely *et al.* '138), as evidenced by MAGS EXPLORER, Gemstones (MAGS EXPLORER), newly cited.

Briefly, Ridgely *et al.* '138 discloses stocking or hosiery that incorporates naturally occurring elements for healing various bodily ailments. These naturally occurring elements may include Alexandrite, Amazonite, amber, Amethyst, Aquamarine, Aventurine, Azurite, Bloodstone, Calcite, Cerebian, Celestite, Chrysoprase, Citrine, Diamond, Diopside, Emerald, Fluorite, Garnet, Gold, Hematite, Herkimer Diamond, Jade, Jasper, Kunzite Pink, Lapis Lazuli, Lepidolite, Malachite, Moonstone, Obsidian, Onyx, Opal, Peridot, Pyrite, Quartz Crystal, Rhodochrosite, Rhodonite, Rose Quartz, Ruby, Rutilated Quartz, Smoky Quartz, Sugilite, Sodalite, Sapphire, Silver, tiger Eye, Topaz, Tourmaline, Turquoise, and Zircon. See column 2, lines 14-28.

Page 5 of MAGS EXPLORER is relied on by the Office Action to allegedly show that "rubellite is merely a red tourmaline."

Responsive to this rejection, Applicants have amended Claim 1 to recite that the first group of elements is selected from charoite, rhyolite, charoite and rhyolite, or a combination of at least one of charoite and rhyolite with at least one of rubellite and rubellite with quartz. Applicants have also amended Claim 22 to recite that the first group of elements is selected from charoite, rhyolite, charoite and rhyolite, and a combination of at least one of charoite and rhyolite with at least one of rubellite and rubellite with quartz.

By contrast, Ridgely *et al.* '138 does not teach or suggest charoite and/or rhyolite, alone or in combination with rubellite and/or rubellite with quartz, according to amended Claims 1 or 22. Accordingly, amended Claims 1 and 22 are novel over Ridgely *et al.* '138,

even as evidenced by MAGS EXPLORER. In addition, Claims 3, 7-10, 16, and 18 ultimately depend from amended Claim 1. Accordingly, Claims 3, 7-10, 16, and 18 are also novel over Ridgely *et al.* '138, even as evidenced by MAGS EXPLORER.

Claim 21, as clarified, recites a first group of naturally occurring elements selected from: (1) a combination of pearl and rhyolite; or (2) a combination of charoite, rubellite, rubellite with quartz, pearl and rhyolite. By contrast, Ridgely *et al.* '138 does not teach or suggest pearl, rhyolite and/or charoite, alone or in combination with rubellite and/or rubellite with quartz, according to Claim 21. Accordingly, Claim 21, as clarified, is novel over Ridgely *et al.* '138, even as evidenced by MAGS EXPLORER.

For at least the foregoing reasons, Claims 1, 3, 7-10, 16, 18, and 21-22, as amended or as currently presented, are novel over Ridgely *et al.* '138, even as evidenced by MAGS EXPLORER.

**C. Response to Rejection of Claims 1, 7, 16 and 18-22 under 35 U.S.C. § 102(b) as Anticipated by Untracht**

At pages 10-11 of the Office Action, Claims 1, 3, 7, 16 and 18-22 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Untracht, O., Jewelry Concepts and Technology (Untracht), as evidenced by MAGS EXPLORER.

Briefly, page 510 of Untracht discloses in photograph 11-55 a symmetrical necklace in sterling silver, with 19 tourmalines. Page 601 of Untracht discloses in photograph 11-55 a gold ring with a flat-topped barrel-shaped tourmaline set in divided bezel.

Page 5 of MAGS EXPLORER is again relied on by the Office Action to allegedly show that “rubellite is merely a red tourmaline.”

Responsive to this rejection, Applicants have amended Claim 1 to recite that the first group of elements is selected from charoite, rhyolite, charoite and rhyolite, or a combination of at least one of charoite and rhyolite with at least one of rubellite and rubellite with quartz. Applicants have also amended Claim 22 to recite that that the first group of elements is selected from charoite, rhyolite, charoite and rhyolite, or a combination of at least one of charoite and rhyolite with at least one of rubellite and rubellite with quartz.

By contrast, Untracht does not teach or suggest charoite and/or rhyolite, alone or in combination with rubellite and/or rubellite with quartz, according to amended Claims 1 or 22. Accordingly, amended Claims 1 and 22 are novel over Untracht, even as evidenced by MAGS EXPLORER. In addition, Claims 7, 16, and 18 ultimately depend from amended Claim 1. Accordingly, Claims 7, 16, and 18-20 are also over novel over Untracht, even as evidenced by MAGS EXPLORER.

Claim 21, as clarified, recites a first group of naturally occurring elements selected from: (1) a combination of pearl and rhyolite; or (2) a combination of charoite, rubellite, rubellite with quartz, pearl and rhyolite. By contrast, Untracht does not teach or suggest pearl, rhyolite and/or charoite, alone or in combination with rubellite and/or rubellite with quartz, according to Claim 21. Accordingly, Claim 21, as clarified, is novel over Untracht, even as evidenced by MAGS EXPLORER.

For at least the foregoing reasons, Claims 1, 7, 16, 18, and 21-22, as amended or as currently presented, are novel over Untracht, even as evidenced by MAGS EXPLORER.

**D. Response to Rejection of Claims 1, 3-11 and 19-25 under 35 U.S.C. § 103(a) as Unpatentable over Untracht**

At pages 12-14 of the Office Action, Claims 1, 3-11 and 19-25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Untracht.

The Office Action concedes that Untracht does not teach: (1) the specific amount of the naturally occurring elements according to Claims 4-6; or (2) the devices (*e.g.*, strap, clothing, furniture, *etc.*) according to Claims 7-10. Instead, the Office Action again alleges that it would have been obvious “to make naturally occurring element combinations in the amounts of from 1 to 10 parts and the narrower range of about 1 to about 2 parts and make devices associated with the combination which are a strap, clothing or furniture including the combination and produce the instant invention.” The alleged “motivation” provided by the Office Action is that “because in the art of making jewelry one of ordinary skill in the art is inclined to mix and match various naturally occurring elements to create various combinations as shown in Untracht,” that “one of ordinary skill in the art can mix and match any naturally occurring elements in any ratio to produce such combinations,” and that “adornment of straps, clothing and furniture is a reasonable extension of the artisan to decorate items for market.”

Applicants again respectfully traverse this rejection of Claims 1, 3-11 and 21-25, as amended or as currently presented, over Untracht for reasons previously presented as to why Claims 1, 7, and 21-22 are novel over Untracht, and for the following additional reasons. With regard to Claims 4-6 and 7-10, this rejection is still *prima facie* improper because the Office Action has failed to properly allege a *prima facie* case of obviousness. As set forth in MPEP § 706.02(j): “To establish a *prima facie* case of obviousness, [the following] criteria must be met. First, *there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings . . . .* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The *teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Appellant’s disclosure.*<sup>1</sup>

As previously pointed out in response to the rejection of Claims 1, 7, and 21-22 as anticipated by Untracht, the reference does not teach or suggest charoite and/or rhyolite, alone or in combination with rubellite and/or rubellite with quartz, according to amended Claims 1 or 22, nor does Untracht teach or suggest pearl, rhyolite and/or charoite, alone or in combination with rubellite and rubellite with quartz, according to Claim 21. Similarly, Claims 23-25, which recite that the first group of naturally occurring elements are a combination of pearl and rhyolite, are also not taught or suggested by Untracht.

In fact, as conceded by the Office Action, Untracht additionally does not teach or suggest other features of Claims 4-6 or Claims 7-10 (which depend from amended Claim 1), namely the specific amounts of the claimed elements, the use of these claimed elements with a strap, clothing, *etc.* In other words, the rejection of these Claims fails to satisfy at least one of the criteria set forth in MPEP § 706.02(j) for a *prima facie* case obviousness, namely the prior art reference must teach or suggest all the claim limitations. Instead, these allegations regarding Claims 4-6 and Claims 7-10 still appear to be based on the Examiner’s personal knowledge.

In response, the Office Action again alleges that the rejection of Claims 4-10 is not based on the Examiner’s personal knowledge, but instead alleges that figure 11-55 of Untracht shows multiple tourmaline stones in a silver necklace, and that figure 13-47 of

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<sup>1</sup> *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also MPEP § 2143- §2143.03 for

Untracht shows a tourmaline in a gold ring.” Based on these alleged teachings, the Office Action alleges that “Untracht establishes using different amounts of components in the compositions (which are designed to decorate the body and hand around the neck or finger) and it is merely judicious selection and routine optimization to create the piece by one of ordinary skill in the art.” But this alleged basis for using different amounts (“by judicious selection and routine optimization”) of tourmaline or any other gem stone is simply unsupported speculation because the reference relied on (Untracht), when fairly read, says nothing about how to vary the amounts of these gemstones, and especially not according to Claims 4-6. In fact, the Office Action’s allegation that the amounts defined in Claims 4-6 involve “routine optimization” is inconsistent and at odds with the Office Action’s allegation that these same Claims lack enablement under 35 U.S.C. § 112, first paragraph.

In addition, the Office Action still fails to identify where the admittedly absent other features of Claims 7-10 (e.g., adornment of straps, clothing and furniture) are shown in the art. Such speculative and unsupported “conclusory statements” by the Office Action violate 37 CFR 1.104(c)(2), as well as the admonition by the United States Supreme Court that determinations of obviousness under 35 U.S.C. § 103 must still be based on supportable reasoning (i.e., based on evidence), not just “conclusory statements.”<sup>2</sup>

The rejection of Claims 4-10 is additionally *prima facie* improper because the Office Action has failed to properly allege any teaching, suggestion or motivation from the reference relied on, or any other verifiable evidence, to support the alleged “judicious selection and routine optimization” of Untracht by one skilled in the art. To properly modify the teachings of Untracht, the Office Action must provide a suggestion, teaching or motivation in the cited references.<sup>3</sup> The suggestion, teaching or motivation may be implicit or explicit.<sup>4</sup> But “[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational

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decisions pertinent to each of these criteria (emphasis added).”

<sup>2</sup> *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_\_ (2007) citing with, with approval, *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006): “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements, instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion obviousness.”

<sup>3</sup> See, e.g., *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988) (“teachings of references can be combined only if there is some suggestion or incentive to do so”).

<sup>4</sup> See e.g., *In re Kahn*, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006) (“A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated by the references....

underpinning to support the legal conclusion obviousness.<sup>5</sup> In fact, the Office Action allegations regarding the “motivation” to alter or modify the teachings of Untracht as suggested is nothing more than speculation which is unrelated to and unsupported by any verifiable factual evidence.

In summary, the Examiner allegations regarding the obviousness of Claims 4-10 over Untracht again appear to be based on his personal knowledge. Accordingly, if the Examiner still wishes to persist in these allegations regarding Claims 4-10, Applicants again respectfully request that he provide an affidavit/declaration under 37 CFR 1.104(d)(2) because these allegations appear to be based on the Examiner’s personal knowledge, and not what is fairly taught by the art relied on in the Office Action.<sup>6</sup>

For at least the foregoing reasons, Claims 1, 3-11, and 21-25, as amended or as currently presented, are unobvious over Untracht.

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<sup>5</sup> See e.g., *In re Kahn*, 78 U.S.P.Q.2d at 1336. See also admonition by the Deputy Commissioner for Patent Operations for the USPTO in a May 3, 2007 memorandum in response to Supreme Court’s recent decision in *KSR International Co. v. Teleflex, Inc.*, 550 U.S. \_\_\_\_ (2007) that “in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.”

<sup>6</sup> Applicants again note that in the unpublished case of *In re Sun*, 31 USPQ2d 1451, 1455 (Fed. Cir. 1993), the USPTO argued “the procedures established by 37 C.F.R. Section 1.107(b) (1993) [now 37 CFR § 1.104(d)(2)] expressly entitle an Applicant, on mere request, to an examiner affidavit that provides [citations that support the Examiner’s asserted level of skill in the art]” (emphasis added). Furthermore, in *In re Sun*, the Federal Circuit, held that “this procedure, so readily available, helps save the lack of citation in an office action from possible constitutional infirmity in denying reasonable notice and hence due process.” See 31 USPQ2d at 1455.



E. **Conclusion**

Claims 1, 3-18 and 21-25, as amended or as currently presented, comply with the enablement requirement under 35 U.S.C. § 112, first paragraph. Claims 1, 3-18 and 21-25, as amended or as currently presented, are also novel and unobvious over the art relied on in the Office Action. Accordingly, Claims 1, 3-18 and 21-25, as amended or as currently presented, should now be in condition for allowance. If the Examiner has any questions or concerns regarding the present response, the Examiner is invited to contact Applicants' representative, Eric W. Gutttag, at 513-856-7272.

The Commission is hereby authorized by this paper to charge any fees during the entire pendency of the present application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 10-0233-VIBP-0001-UT1.

Respectfully submitted,

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